



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/879,160

06/13/2001

Shigehisa Tonomura

1341.1095

3652

21171 7590 10/17/2008

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

KE, PENG

ART UNIT

PAPER NUMBER

2174

MAIL DATE

DELIVERY MODE

10/17/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/879,160	<b>Applicant(s)</b> TONOMURA, SHIGEHISA	
	<b>Examiner</b> SIMON KE	<b>Art Unit</b> 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9, 11 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 11, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

Art Unit: 2174

### **DETAILED ACTION**

This action is responsive to communications: Amendment, filed on 7/15/08.

Claims 1-5, 9, 11, and 21 are pending in this application. Claims 1, 9, 11, and 21 are independent claims. In amendment filed on 7/15/08, claims 1, 9, and 11 were amended and claim 21 was added.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21 rejected under 35 U.S.C. 102(e) as being anticipated by Fuller US Patent 6,833,865.

Fuller teaches a method comprising:

Separately acquiring and storing, in separate storages, based on time or position, content that can be inserted in a picture and the picture that includes position information; and (see Fuller, col. 7, lines 15-30; see figure 5; items 703 and 704)

Inserting and editing the content into a section of the picture that corresponds to positional information of the picture. (see Fuller, col. 8, lines 44-55, wherein the metadata regarding the text to voice position analysis is added to the content at a different time)

***Claim Rejections – 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 5, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ashizaki, U.S. Patent No. 6,829,430 in view of Yoon et al., U.S. Patent No. 6,173,407 in view Fuller et al. US Patent No. 6,833,865 further in view Flamini et al. US Application Publication 2004/0100486.

As per claim 1, Ashizaki teaches an information providing method comprising the steps of: accepting photographed data including photographing position information from a user (see Ashizaki, column 17, lines 63-column 18, lines 20);

acquiring a content to be inserted into the photographed data wherein said content corresponds to the photographing position information and is acquired from a position-distinction contents database based on the photographing position information in the accepted photographed data, wherein said position-distinction contents database stores photographing position information and the content in a correlated manner (see Ashizaki, column 19, lines 16-35); and

inserting and editing the acquired content into a portion of the photographed data corresponding to the photographing position information (see Ashizaki, column 10, lines 40 – 64), wherein the content includes image data or sound data symbolizing an area which

Art Unit: 2174

corresponds to the photographing position information (see Ashizaki, column 21, lines 40-65; column 17, lines 63-column 18, lines 20).

However, Ashizaki fails to include fee information that corresponds to the data, said fee information being provided according to inserted and edited files.

Yoon teaches content that includes fee information that corresponds to the data, (see Yoon, column 7, lines 9 – 50), said fee information being provided according to inserted and edited files. (see Yoon column 1, lines 40-45; Charges is the same as fee)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Yoon with the method of Ashizaki in order to generate revenue for the content provider.

However, they fail to teach the contents and the photographed data are stored in separate storages and the contents and photographed data are acquired separately in time and or position;

Fuller teaches the contents and the photographed data are stored in separate storages; (see Fuller, col. 7, lines 15-30; see figure 5; items 703 and 704) and the contents and photographed data are acquired separately in time and or position (see Fuller, col. 8, lines 44-55, wherein the metadata regarding the text to voice position analysis is added to the content at a different time)

It would have been obvious to an artisan at the time of the invention to include Fuller's teaching with method Yoon and Ashizaki in order to provide users with object orientated data structure.

However, they fail to teach the contents are inserted and edited into the photographed data when the user requests.

Art Unit: 2174

Flamini teaches the contents are inserted and edited into the photographed data when the user requests. (see Flamini paragraph 0100)

It would have been obvious to an artisan at the time of the invention to include Flamini's teaching with method Yoon, Ashizaki, and Fuller in order to provide users with ability to add metadata to the user selected image.

As per claim 2, which is dependent on claim 1, Ashizaki, Yoon, Fuller, and Flamini teach the method of claim 1 (see rejection above). Yoon et al. ("Yoon") further teaches teaches an information providing method comprising the step of calculating an appropriate fee for providing content (see Yoon, column 7, lines 9 – 50).

As per claim 3, which is dependent on claim 1, Ashizaki, Yoon, Fuller, and Flamini teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method according to claim 1, wherein the accepting step further includes the steps of, accepting information for specifying the user along with the photographed data including the photographing position information (see Ashizaki, column 17, lines 63-column 18, lines 20); and transmitting the inserted and edited photographed data to the user based on the accepted information for specifying the user (see Ashizaki, column 10, lines 40 – 64).

As per claim 4, which is dependent on claim 1, Ashizaki, Yoon, Fuller, and Flamini teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method according to claim 1, wherein the photographed data are data photographed in a certain

Art Unit: 2174

bigger area, and the photographing position information is information about a smaller area in the bigger area where the photographing is executed or information showing a photographing spot (see Ashizaki, figure 4, items 18, and 28).

As per claim 5, which is dependent on claim 1, Ashizaki, Yoon, Fuller, and Flamini teach the method of claim 1 (see rejection above). Ashizaki further teaches the information providing method according to claim 1, wherein the photographed data are frames of original dynamic images (see Ashizaki, column 13, lines 43 – 56; the examiner interprets images captured by a digital video recorder as frames of original dynamic images).

As per claims 9 and 11 they are of similar scope to claim 1 and are rejected under the same rationale as claim 1 (see rejection above),

### ***Response to Arguments***

Applicant's arguments filed 1-5, 9, 11, and 21 have been fully considered but they are not persuasive.

Applicant argued that Fuller fails to teach acquired the contents and the photographed data separately in time.

Examiner disagrees. Fuller teaches this limitation because it inserts the voice to text position data generated by its analysis program after it have already recorded pictures. (see figure 5, items 804, 806, col. 8, lines 43-56) Therefore Fuller acquires the contents and the photographed data separately in time.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SIMON KE whose telephone number is (571)272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2174

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Peng Ke  
/Peng Ke/  
Primary Examiner, Art Unit 2174